

REMARKS

I. Introduction

Claims 14-16 and 40-48 were pending in this application.

All pending claims were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond et al. U.S. Patent No. 6,698,020 (hereinafter "Zigmond"), in view of Russo U.S. Patent No. 5,619,247 (hereinafter "Russo") and Mori Japanese Patent No. JP 10162484 A (hereinafter "Mori")¹.

Applicant has amended claims 14, 15, 40, 41, 43, 44, 46, and 47 to more particularly define the subject matter of the claimed invention. In addition, applicant has added new claims 69-80. These amendments are fully supported by the application as originally filed and do not add new matter. The Examiner's claim rejections are respectfully traversed.

II. Claims 14-16 and 40-48

Generally speaking, each of amended independent claims 14, 40, 43, and 46 is directed toward presenting a forced advertisement on user equipment. The user equipment automatically presents the forced advertisement from the beginning of the forced advertisement when the user equipment is turned back on after the user equipment is turned off while the forced advertisement is being presented on the user equipment.

Zigmond refers to selecting and inserting advertisements into a video programming feed. To address advertisement avoidance by "aggressive channel surfers," Zigmond inserts a particular advertisement into each advertisement slot that a channel surfer encounters, or alternatively, simultaneously broadcasts a selected advertisement on all channels. See Zigmond, column 13, ll. 16-39.

Russo refers to replaying of stored pay-per-play programs. To ensure that a viewer is only billed after substantially viewing the rented program, if "viewing is stopped and restarted, for whatever reason, including the viewing of another program on an intervening basis, the system will

¹Let the record reflect that Mori is a Japanese Language reference and the Examiner only provided an English language translation of the Abstract. Furthermore, reference was not made in the Office Action to the full text of Mori. Therefore, in accordance with MPEP § 706.02 (II), the evidence relied upon in this response is the facts contained in the Abstract, not additional facts that may be contained in the underlying full text. Applicant hereby reserves the right to submit additional arguments in view of the full text if applicant deems it necessary.

automatically keep track of where viewing left off, and restart from that point until such program has been viewed substantially in its entirety." (Russo, column 5, ll. 14-19).

Mori refers to a "CD reproducing device" which is able to resume reproducing from a "reproducing interrupted spot" without any time delay when a power source is switched ON again after the power source is switched OFF (Mori, Abstract).

The Examiner contends that an alleged combination of Zigmond, Russo, and Mori shows applicant's claimed feature of turning off user equipment on which a forced advertisement is being presented and automatically presenting a forced advertisement from the beginning of the forced advertisement when the user equipment is turned back on. Applicant disagrees.

Zigmond, Russo, and Mori (or the alleged combination thereof) fail to teach or suggest this subject matter. The Examiner concedes that Zigmond fails to teach this subject matter (see Office Action, page 3, lines 13-16). Russo and Mori fail to make up for this deficiency in Zigmond. In particular, both Russo and Mori teach resuming an interrupted program from the point at which the interruption occurred, not starting from the beginning of the interrupted program. Therefore, modifying Zigmond, in the manner suggested by the Examiner, to include the resuming features of Russo and Mori would not enable the resulting combination to automatically present a forced advertisement from the beginning, as taught by applicant. Furthermore, resuming an interrupted program from the point at which the interruption occurred, as required by Russo, Mori, and their alleged combination with Zigmond, teaches away from automatically presenting a forced advertisement from the beginning, as is recited in the claims. Thus, Zigmond, Russo, and Mori, taken individually or in combination, fail to teach or suggest all the features of amended independent claims 14, 40, 43, and 46 as is required for a proper rejection under § 103 (see MPEP § 2142).

For at least the foregoing reasons, independent claims 14, 40, 43, and 46 are not obvious over Zigmond, Russo, and Mori. Therefore, applicant requests reconsideration and withdrawal of the § 103 rejection of independent claims 14, 40, 43, and 46. Applicant also requests reconsideration and withdrawal of the § 103 rejection of dependent claims 15, 16, 41, 42, 44, 45, 47, and 48 for at least the same reasons.

III. New Claims 69-80

Generally speaking, each of new independent claims 69, 72, 75, and 78 is directed toward automatically presenting a forced advertisement on user equipment. When the user equipment is turned off while the forced advertisement is being presented, the forced advertisement is automatically presented from the point at which the user equipment was turned off when the user equipment is turned back on.

The Examiner relies on an alleged combination of Zigmond, Russo, and Mori in rejecting this subject matter under § 103 in pending claims 14, 40, 43, and 46. In support of this rejection, the Examiner alleges that it would be obvious to modify Zigmond to include the resuming features taught by Russo and Mori. Applicant disagrees.

In particular, the combination of Zigmond and Russo is improper because they teach away from their combination (see, e.g., MPEP § 2145 [X-D.02]). Although both Russo and Zigmond refer to resuming interrupted media, they refer to very different media entities and teach very different approaches for doing so. The pay-per-view system in Russo is directed to a pay-per-view program that the viewer clearly desires to watch, as evidenced, for example, by the viewer's willingness to order that particular program for viewing. In keeping with this principle, Russo permits the viewer to view other programs on an intervening basis and allows the viewer to resume viewing of the rented program at the viewer's convenience. Furthermore, a viewer who terminates viewing of the program shortly after starting said viewing is not forced to continue viewing of the rented program. (See Russo, column 5, lines 10-33). In fact, the principle behind Russo's tracking and resuming feature is to ensure that viewers can abort viewing of programs they have not enjoyed substantially in their entirety without being billed for such programs (see Russo, column 3, lines 5-10). This is in direct contrast with Zigmond, which refers to an advertisement that the viewer, classified as an "aggressive channel surfer" by Zigmond, wishes to avoid viewing by changing the channel to one broadcasting programming. Whereas Russo teaches that the viewer be permitted to view other programs on an intervening basis, Zigmond teaches that the viewer be presented with the particular advertisement as the viewer progresses through the channel lineup so that the viewer is "repeatedly exposed to at least bits and pieces of the one particular advertisement." (See Zigmond, column 13, lines 28-39). Modifying Zigmond, in the manner suggested by the Examiner, to include the video resuming feature taught by Russo would require permitting an aggressive channel surfer to view other programs on an intervening basis with the

advertisement, or terminate viewing of the advertisement altogether, in direct contrast with the teachings and principles of Zigmond. For the purposes of a § 103 rejection, "[i]t is improper to combine references where the references teach away from their combination" (MPEP § 2145 [X-D.02]). Therefore, the combination of Zigmond and Russo is improper as a matter of law.

Furthermore, Mori fails to provide a basis for resolving the contradictory teachings of Zigmond and Russo. Therefore, the alleged combination of Russo, Zigmond, and Mori is improper for the reasons stated above. Moreover, the English language translation of the Mori abstract provided by the Examiner in support of the rejection fails to adequately convey the nature of the system taught in Mori. For example, applicant is unable to ascertain whether "CD reproducing" in Mori refers to playback of a CD or duplication of a CD. Applicant is also unable to determine if there are teachings in Mori that may lead away from the claimed invention or from a combination with Russo and Zigmond. Therefore, if the Examiner intends to maintain the § 103 rejection based on Mori, applicant respectfully requests that the Examiner provide an English language translation of the underlying Japanese language text with the next Office Action.

For at least these reasons, independent claims 69, 72, 75, and 78 are not obvious over Zigmond, Russo, and Mori. Applicant, therefore, requests consideration and allowance of independent claims 69, 72, 75, and 78. Applicant also requests consideration and allowance of dependent claims 70, 71, 73, 74, 79, and 80 for at least the same reason.

IV. Dependent Claims 15, 41, 44, 47, 70, 73, 76, and 79

Furthermore, certain ones of the dependent claims further patently distinguish over the alleged combination of Zigmond, Russo, and Mori. For example, each of dependent claims 15, 41, 44, 47, 70, 73, 76, and 79 further require preventing the user from changing channels while the forced advertisement is being presented. In rejecting the subject matter of these claims, the Action asserts that "[c]olumn 13, lines 16-39 [of Zigmond] disclose a way of curbing 'aggressive channel surfing' which forces the user to view commercials in their entirety and does not allow the switching of channels to other programs before the commercial is fully viewed." (Office Action, Page 4, lines 12-17).

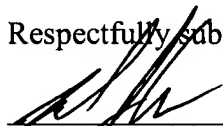
Applicant disagrees. As discussed above, the cited section of Zigmond merely teaches inserting a particular advertisement into each advertisement slot that a channel surfer encounters, or

alternatively, simultaneously broadcasts a selected advertisement on all channels. Therefore, Zigmond does not teach preventing the viewer from changing channels while a forced advertisement is being presented. Thus, contrary to the Action's assertion, Zigmond fails to show this claimed feature. For at least this additional reason, applicant requests reconsideration and withdrawal of the § 103 rejection of dependent claims 15, 41, 44, and 47. Applicant also requests consideration and allowance of claims 70, 73, 76, and 79.

V. Conclusion

For at least the foregoing reasons, applicant respectfully submits that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,



Michael J. Chasan
Reg. No. 54,026
Agent for Applicant
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1211 Avenue of the Americas
New York, New York 10036-8704
(212) 596-9000